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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,071

09/30/2003

Peter HN Tran

66329/31282

5069

23380 7590 05/19/2008

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EXAMINER

ROBINSON, MYLES D

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

05/19/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/675,071	<b>Applicant(s)</b> TRAN ET AL.	
	<b>Examiner</b> Myles D. Robinson	<b>Art Unit</b> 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 29 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment was received on 1/29/2008, and has been entered and made of record. Currently, **claims 1 – 20** are pending.

### ***Response to Arguments***

2. Applicant's arguments (*see Remarks 1/29/2008, page 9*) with respect to **claims 3 and 12 – 20** have been fully considered and are persuasive. The 35 U.S.C. §12, second paragraph rejections of claims 3 and 12 – 20 have been withdrawn.
3. Applicant's arguments (*see Remarks 1/29/2008, pages 9 – 10*) with respect to **claims 1 – 20** have been considered but are moot in view of the new ground(s) of rejection.

### ***Drawings***

4. The drawings were received on 1/29/2008. These drawings are acceptable.

### ***Specification***

5. The amendments to the specification were received on 1/29/2008. These amendments are acceptable.

### ***Claim Rejections - 35 USC § 112***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. **Claims 1 – 20** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claims 1 and 11** recite the limitation "the at least one file" in lines 13 and 14, respectively. There is insufficient antecedent basis for this limitation in the claim. All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected as well.

8. Regarding **claims 11 and 14 – 17**, the phrases "adapted to" and "adapted for" render the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d), 2111.04.

Description of examples or preferences is properly set forth in the specification rather than in the claims. If stated in the claims, examples and preferences may lead to confusion over the intended scope of a claim. See MPEP 2173.05(d).

The phrase "adapted to" or "adapted for" is language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure; therefore, it does not limit the scope of a claim or claim limitation. See MPEP 2106 II (c).

Where means plus function language is used to define the characteristics of a machine or manufacture invention, such language must be interpreted to read on only

the structures or materials disclosed in the specification and "equivalents thereof" that correspond to the recited function. See MPEP 2106 II (c).

The Applicant discloses several preferred embodiments wherein the certain functions are carried out "by any suitable means" such that the claimed means cannot be clearly correlated to the elements set forth in the written description that perform the recited step or function (*see Specification [page 10, lines 12 – 20]*).

All claims dependent upon these claims suffer the same deficiency and, therefore, are rejected as well.

### ***Claim Rejections - 35 USC § 102***

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. ***Claims 1, 3, 7, 11, 13 and 17*** are rejected under 35 U.S.C. 102(e) as being anticipated by **Anderson et al.** (U.S. Patent No. 6,892,251).

Referring to **claim 11**, Anderson discloses system for processing a document (*see Fig. 1, documents 198, 199*) from a portable data storage device (*see Fig. 1, portable device 166*), comprising:

means adapted to receiving an associated portable data storage device (*see Fig. 1, portable device 166 [column 4, lines 13 – 17]*) into a document rendering device (*see Fig. 1, local printer 116 [column 3, lines 39 – 62]*), the portable data storage device inclusive of at least one electronic document stored in a native application format from which it was generated (*see Figs. 1 – 2 wherein document relay service 196 determines*

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*in step 206 whether documents downloaded from portable device 166 are printer ready [i.e. rendered by an appropriate application 176] in step 209 or whether the downloaded document needs to appropriately rendered in step 213 [column 6, lines 47 – 65]),*

means adapted for receiving administrative data representative of document processing privilege (see Figs. 1 and 3 wherein document rendering service 183 determines the file type [i.e. administrative data] of the temporary file in step 309 in order to subsequently search for compatible applications for processing in step 313 [column 7, lines 13 – 15]),

means adapted for selectively activating, in accordance with received administrative data, a document processing service associated with the document rendering device upon insertion of the portable data storage device (see Fig. 3, step 313 [column 7, lines 16 – 25]),

means adapted for generating a user prompt as to document processing options associated with the portable data storage device (see Fig. 3 wherein the appropriate application is launched in accordance with the file type of the non-rendered document 198 in steps 326 and 329 for processing of that document [column 7, lines 30 – 47 and 57 – 64]),

means adapted for receiving user input as to at least one selected document processing option to be performed on the at least one file (see Fig. 3 wherein the appropriate application 176 is launched, or opened, in step 329 or the document is applied to an already opened compatible application 176 in step 326 which suggests that document rendering service 183 allows for the user to utilized opened applications

*176 for further input or document processing of that document [column 7, lines 30 – 47 and 57 – 64]),*

means adapted for testing a native application format of the at least one electronic document relative to capabilities of the associated document rendering device  
*(see Figs. 1 and 3 wherein document rendering service 183 searches for compatible applications for rendering documents in steps 313 and then performs the compatibility test whether the document can possibly be rendered by system 100 in step 316 [column 7, lines 16 – 25]),*

means adapted for generating a display corresponding to available document processing operations available on the at least one electronic document in accordance with an output of the step of testing *(see Figs. 1 and 3 wherein the compatible application is launched with instructions to print the document in steps 326 and 329 [column 7, lines 34 – 39, 57 – 64 and column 8, lines 51 – 45] and conversely, if all of the applications 176 of system 100 are incompatible with the non-rendered document 198, then a print failure message is generated to inform the user in step 319 [column 7, lines 47 – 55]),* and

means adapted for commencing operation of the associated document rendering device in accordance with received user input and available document processing operations *(see Fig. 3 wherein the appropriate application 176 is launched, or opened, in step 329 or the document is applied to an already opened compatible application 176 in step 326 which suggests that document rendering service 183 allows for the user to utilized opened applications 176 for further input or document processing of that*

*document [column 7, lines 30 – 47 and 57 – 64] and see Figs. 1 and 3 wherein the compatible application is launched with instructions to print the document in steps 326 and 329 [column 7, lines 34 – 39, 57 – 64 and column 8, lines 51 – 45]).*

Referring to **claim 13**, Anderson discloses the system further wherein the portable data storage device is a universal serial bus data storage device (see Fig. 1, portable device 166 [column 4, lines 13 – 17]).

Referring to **claim 17**, Anderson discloses the system further comprising means adapted for selecting processing parameters associative of the document processing options (see Figs. 1 and 3 wherein document rendering service 183 searches for compatible applications for rendering documents in steps 313 and then performs the compatibility test whether the document can possibly be rendered by system 100 in step 316 [column 7, lines 16 – 25] and see Figs. 1 and 3 wherein the compatible application is launched with instructions [i.e. processing parameters] to print the document in steps 326 and 329 [column 7, lines 34 – 39, 57 – 64 and column 8, lines 51 – 45]).

Referring to **claims 1, 3 and 7**, the rationale provided in the rejection of claims 11, 13 and 17, respectively, are incorporated herein. In addition, the systems of claims 11, 13 and 17 perform the methods of claims 1, 3 and 7, respectively.

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the



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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 2 and 12** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Anderson et al.** (U.S. Patent No. 6,892,251).

Referring to **claim 12**, Anderson discloses the system as discussed above in the rejection of claim 11 but does not explicitly disclose the system further wherein the document processing options are displayed on a menu on a display console located on the document rendering device.

However, the Examiner takes Official Notice that a display console located on the document rendering device [e.g. printer, copier, MFD], which displays the document processing options in a menu, is conventional and well known.

It would have been obvious at the time the invention was made to one of ordinary skill in the art to include a printer with a control panel displaying menu options along with the printer of Anderson since the Examiner takes Official Notice that the control panels [e.g. display consoles] built into printers, copiers, MFDs, etc. are conventional and well known.

Referring to **claim 2**, the rationale provided in the rejection of claim 12 is incorporated herein. In addition, the system of claim 12 performs the method of claim 2.

13. **Claims 4 – 6, 8 – 10, 14 – 16 and 18 – 20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Anderson et al.** (U.S. Patent No. 6,892,251) in view of **Yajima et al.** (U.S. Patent No. 6,862,104).

Referring to **claims 14 – 16**, Anderson discloses the system as discussed above in the rejection of claim 11 but does not explicitly disclose the system further wherein the document processing option is an electronic mail request or a facsimile request or a print request, further comprising means adapted for displaying a menu of at least one action corresponding to the document processing option, means adapted for selecting one of the at least one action displayed, and means adapted for performing the document processing option in accordance with the selected at least one action.

Yajima discloses the system wherein the document processing option is an electronic mail request or a facsimile request or a print request (*see Fig. 1 wherein selection keys 8 activate modes for either a copier, scanner, printer, e-mail facsimile or usual [telephonic] facsimile [column 4, lines 50 – 55]*), further comprising:

means adapted for displaying a menu of at least one action corresponding to the document processing option (*see Fig. 2 wherein the facsimile job request options are displayed in a menu and see Fig. 3 wherein the e-mail job request options are displayed in a menu [column 4, line 64 – column 5, line 3]*),

means adapted for selecting one of the at least one action displayed (*see Figs. 1, 3, control panel portion 1, display portion 2 [column 4, lines 14 – 33]*), and

means adapted for performing the document processing option in accordance with the selected at least one action (*see Abstract*).

Anderson and Yajima are combinable because they are from the same field of endeavor, being walk-up printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to include document processing options

such as facsimile and e-mail transmission capabilities, along with a walk-up printer. The suggestion/motivation for doing so would have been to meet the sharply rising world-wide communication demands of businesses, as suggested by Yajima (*column 1, lines 7 – 40 and column 4, lines 10 – 15*).

Referring to **claim 18**, Anderson and Yajima disclose the system as discussed above in the rejection of claim 17 but neither Anderson nor Yajima explicitly disclose the system further wherein the processing parameters are image medium parameters.

However, the Examiner takes Official Notice that the selection of image medium parameters, such as color, size and type of paper stock (e.g. tabbed, A4, legal, poster, drilled, etc.), in printing systems is conventional and well known.

It would have been obvious at the time of the invention was made to one of ordinary skill in the art to load a variety of paper stock within the walk-up printing systems of Anderson and Yajima since the Examiner takes Official Notice that the use of multiple trays with various styles of paper supplies and/or allowing the user to remove one type of paper supply and reload the printer with another type of paper supply is conventional and well known.

Referring to **claim 19**, Yajima discloses the system further wherein the processing parameters are image transmission parameters (*see Fig. 1 wherein selection keys 8 activate modes for either an e-mail facsimile transmission mode or usual [telephonic] facsimile transmission mode [column 4, lines 50 – 55]*).

Referring to **claim 20**, Yajima discloses the system further wherein the processing parameters are image output location parameters (*see Fig. 4 wherein both*

*the addresses to which usual facsimile transmission and e-mail facsimile transmission are displayed in combination [column 5, lines 16 – 32]).*

Referring to **claims 4 – 6 and 8 – 10**, the rationale provided in the rejection of claims 14 – 16 and 18 – 20, respectively, are incorporated herein. In addition, the systems of claims 14 – 16 and 18 – 20 perform the methods of claims 4 – 6 and 8 – 10, respectively.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Gomes et al.** (U.S. Patent Application Publication No. 2003/0076529) discloses a printing method using a portable device wherein the user designates a first document among the documents to be printed as an instruction in a portable device (*see Abstract and Figs. 1 and 3*).

**Tsuchittoi** (U.S. Patent No. 6,831,753) discloses a printing apparatus which discriminates whether received print data is print data converted into a job packet or print data which is not converted into a job packet and switches the processing operation in accordance with the print data (*see Abstract and Figs. 1 and 5*).

**Toyoda et al.** (U.S. Patent No. 5,881,233) disclose a printer with both electronic mailing and facsimile transmission capabilities (*see Abstract and Fig. 24*).

**Pochuev et al.** (U.S. Patent Application No. 2002/0186393, European Patent No. 1 267 254 and Japanese Patent No. 2003-044245) disclose document printing

using format-specific translation modules wherein a printer is configured to convert an electronic document from a native format to a print-ready format (see *Abstract and see Figs. 4 and 5*).

**Reich et al.** (Japanese Patent No. 2003-099214) disclose a method of automated rendering to print to file comprising a rendering service which comprises logic that identifies an application employed to generate a digital document and logic that identifies a select rendering application from a number of rendering applications to render the document into an output file embodied in a predefined file format (see *Abstract*).

**Brindle et al.** (U.S. Patent No. 5,526,469) disclose a system for printing image data in a versatile print server such that the system operatively connects a source of a quantity of digital data having an image data format associated therewith and creates a print of the original image based on the digital data and comprising a library which includes a plurality of selectable format variable sets, each format variable set corresponding to an image data format (see *Abstract and Fig. 1*).

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Myles D. Robinson whose telephone number is (571)272-5944. The examiner can normally be reached on M-F 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler L. Haskins can be reached on (571) 272-7406. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 2625  
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